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09/814,243	03/21/2001	Edmund H. Louie	72167.000236	2002

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EXAMINER

AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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12/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/814,243

Applicant(s)

LOUIE ET AL.

Examiner

Olabode Akintola

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34-66 is/are pending in the application.
- 4a) Of the above claim(s) 56-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of claims 34-55 in the reply filed on 10/30/2007 is acknowledged.

### ***Claim Objections***

Claims 35-44 are objected to because of the following informalities: These claims depend on canceled claim 33. Appropriate correction is required. For examination purposes, Examiner interprets the claims as being dependent on claim 34.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 45-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 45-55 are directed to a computer program per se or data structure of a computer or software and therefore not statutory under 35 U.S. C. 101. This is exemplified in In re Warmerdam 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material,

including computer programs, per se, is not patent eligible subject matter.

Functional descriptive material claimed in combination with an appropriate computer readable medium to enable the functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete and tangible result when used in the computer system. Compare Warmerdam to In re Lowry 32 USPQ2d 1031 where a memory with a data structure that increased computing efficiency was patentable.

The computer readable medium loaded with a computer program and in association with a computer provides the functional descriptive material in usable form to permit the functionality to be realized with the computer. A program product which does not explicitly include such a medium, a program per se, a signal or other type of transmission media that fails to include the hardware necessary to realize the functionality (e.g., a transmitter or a receiver), and a piece of paper with the functional descriptive material written on it are all examples of media which are not believed to enable the functionality to be realized with the computer. “[I]nstructions for creating...” is considered as a source code or software per se.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 34-36, 40-47 and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel et al (USPN 5940812) (hereinafter referred to as Tengel) in view of Atkins (USPN 4953085) (hereinafter referred to as Atkins) in view of Walker et al (USPN 6484153) (hereinafter referred to as Walker) in view of Rutter, J (Deals in Cyberspace, Euromoney, London, Feb. 1998) (hereinafter referred to as Rutter) and further in view of Cyber street (Wall Street and Technology, New York, June, 1997) (hereinafter referred to as CyberStreet).

Re claims 34 and 45: Tengel teaches a client server-based loan management system for managing loans, comprising:

a borrower interface for accessing the system over a communication network (Fig. 1, RN {104}, col. 2, lines 33-36);

a borrower management module accessible via the borrower interface and storing therein borrower information including at least borrower contact information, funds transfer instructions, and a borrower fee schedule (Fig. 1, RN {110}, col. 2, lines 38-45);

an investor interface for accessing the system over a communication network (Fig. 1, RN {102}, col. 2, lines 59-61);

an investor management module accessible via the investor interface and storing therein investor information including at least investor contact information, funds transfer instructions, and tax information (Fig. 1, RN {110}, Fig. 7, col. 2, lines 64-67);

a syndicate manager interface for accessing the loan management system over a communication network (Fig. 1, RN {111}, col. 2, lines 59-61).

Tengel does not explicitly teach a transaction management module for maintaining information corresponding to particular transaction; a loan management module comprising sub-modules; and a report module as recited in the claim.

Atkins teaches a transaction management module for maintaining information corresponding to particular transaction (col. 12, lines 15-39); and a report module in communication with other modules (col. 12, lines 40-55; col. 19, lines 64-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tengel to include a transaction management module and a report module. One would have been motivated to do so in order to receive, store and monitor records of transactions for reporting to appropriate entities.

Walker teaches a borrower interface, an investor interface and a central controller that manages the transaction between the borrower and the investor. The central controller (loan management module) includes several databases (sub-modules) for different functions in communication with one another (abstract, Fig. 1-8, col. 5 lines 65- col. 7, line 67). Walker does not specifically teach syndicate loan sub modules and facility management sub module. However, Rutter teaches a loan management module and a reporting module to manage and monitor syndicated loans from signing to maturity catering for the whole life-cycle of the loan (paragraphs 3-5). Also CyberStreet teaches a database that stores information about syndicated deals (paragraph 2). It

would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tengel's central processor (109) to include these databases as taught by Walker, Rutter and CyberStreet. One would have been motivated to do so in order to have various functions assigned to the various databases, thereby enhancing the system's functionality.

Re claim 35 and 46: Tengel does not explicitly teach a loan portion ownership transfer module operable to inform lenders in said loan management system of a first lender offering a loan portion for at least one of a sale and a trade; said module being further operable to consummate said at least one of said sale and said trade, whereby recordation of a transfer of said loan portion ownership is made in said loan management system; and said transfer module is further operable to notify said first lender and an other party to said transfer of consummation of said transfer.

Official notice is hereby taken that it is old and well known in the art to have modules that offer loans for at least one of a sale and a trade. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tengel to include these steps, because it greatly improves the efficiency of the system by allowing lenders to build liquidity and support additional lending. Support for this Official notice can be found in *McClelland et al (US 5689650) at col. 2, lines 2-8.*

Re claims 36 and 47: Tengel teaches business logic module including stored criteria for determining if parameters of a transaction are within appropriate value ranges, wherein said business logic is operable to receive and analyze a transaction request from said user through

said user interface and operable to approve said transaction request based on said criteria (see abstract, Figs. 2A, RN {202}, 3A).

Re claim 40 and 51: Tengel teaches a contact list including contacts for said plurality of lenders and for said at least one borrower (abstract, Fig. 7, col. 10, lines 27-33).

Re claim 41 and 52: Tengel teaches an external data system coupled to the loan management system, wherein a user can provide instructions to loan management system through said user interface module to access said external data system; and said access to said external data system can be used to compare said loan information with external data, and import and export data to and from the loan management system (Fig. 1, RN {116, 117}).

Re claim 42-44 and 53-55: Tengel teaches generating messages to at least one of said plurality of lenders, said at least one borrower and at least one contact related to said plurality of loan resources; wherein said generated messages must be approved and released for transmission by a user having approval and release authorization; wherein said generated messages contain all information needed to initiate a loan for use as one of said plurality of loan resources; wherein said generated messages contain all information needed to initiate a loan for use as one of said plurality of loan resources (abstract).



Claims 37 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel in view of Atkins in view of Walker in view of Rutter in view of CyberStreet and further in view of Norris (US Patent 5940811) (hereinafter referred to as Norris).

Re claims 37 and 48: Tengel does not explicitly teach wherein the investor management module further comprises: a set of funds transfer instructions for each of said plurality of lenders; and each of said funds transfer instructions having a status indicative of whether said funds transfer instructions are pending or approved.

Norris teaches wherein the investor management module further comprises: a set of funds transfer instructions for each of said plurality of lenders; and each of said funds transfer instructions having a status indicative of whether said funds transfer instructions are pending or approved (col. 4, lines 1-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tengel to include these steps as taught by Norris because providing said instructions allow for easier and faster movement of funds within the system as well as eliminating bias in the decision to approve or deny the loan.

Claims 38 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel in view of Atkins in view of Walker in view of Rutter in view of CyberStreet and further in view of CFO Alert ("New Medium Brewing For Syndications") (hereinafter referred to as CFO).

Re claims 38 and 49: Tengel does not explicitly teach an agent fee calculation module operable to calculate an agent fee; and said agent fee related to at least one of transactions for and amounts

of said loan resources. CFO teaches an agent fee calculation module operable to calculate an agent fee; and said agent fee related to at least one of transactions for and amounts of said loan resources (Pg. 1, lines 59-61). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tengal to include this step as taught by CFO. One would have been motivated to do this in order to allow the agent receive payment for his services.

Claims 39 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengal in view of Atkins in view of Walker in view of Rutter in view of CyberStreet and further in view of Nickles (USPN 6134591).

Re claims 39 and 50: Tengal does not explicitly teach a user access authorization module; and an access authorization level assigned to said user, whereby said user is granted access to various portions of said loan management system based on authorization accorded to said user by said user access authorization module determined by said access authorization level. Nickles teaches a user access authorization module; and an access authorization level assigned to said user, whereby said user is granted access to various portions of said loan management system based on authorization accorded to said user by said user access authorization module determined by said access authorization level (col. 6, lines 7-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tengal to include these steps as taught by Nickles so that different users can have varying levels of access based on their user identifications and passwords.

***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629.

The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

  
HANI M. KAZIMI  
PRIMARY EXAMINER